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10/066,005

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Neil D. Scancarella

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EXAMINER

YU, GINA C

JULIE BLACKBURN

REVLON CONSUMER PRODUCTS CORPORATION

237 PARK AVENUE

NEW YORK, NY 10017

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/066,005

Applicant(s)

SCANCARELLA ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 1-16, 24-37 and 51-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-23, 38-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 9, 2004 has been entered.

### ***Election/Restrictions***

Applicant's election "polymeric alpha olefins" among the recited wetting agents in the reply filed on June 22, 2004 is confirmed. Applicants assert in remarks filed on December 2, 2004, that it would not be "necessary to search each overcoat separately absent consideration of the other limitations in the claims with respect to the separate receptacles and the and the multipack cosmetic" since the claimed invention is not a composition. The argument is unpersuasive because the claimed invention is composed of compositions. Examiner respectfully points out to the fact that the now-withdrawn claims contain limitations of the non-elected wetting agents that are enumerated in the Markush claim, Claim 17. Searching all of these unrelated species of wetting agents would have imposed a significant burden on the examiner. Claims 17-23, 38 – 50 read on the elected species and examined on the merits in this Office action.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 17-19, 38-44, and 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler et al. (US 6074654) ("Drechsler") in view of Jennings et al. (US 4699780) ("Jennings") and Litton (US 5970989).**

Drechsler discloses a method of enhancing the gloss, shine, and feel of lip composition by apply a complimentary product, known as "overcoat" or "topcoat", over the film formed after application of a transfer-resistant lip composition. See col. 10, line 63 – col. 16, line 7. As for the film-forming coloring composition, the reference teaches using (i) crosslinked organosiloxane resins such as Wacker 803 from Wacker Silicones Corp. (trimethylsiloxysilicate); (ii) volatile carriers, most preferably isododecane; and (iii) pigments. See col. 7, line 46 – col.9, line 2. The reference also teaches in col. 2, lines 7-13 that it is well known in the art to formulate a transfer-resistant cosmetic composition with trimethylated silica and volatile solvent. Combining organic, D & C pigments and inorganic titanium dioxide is taught in Example 3. See instant claims 49 and 50. The reference also teaches that the overcoating composition can be liquid or solid and include "any that are commercially available or to be developed, provided the aggregate of the materials comprising the overcoat does not significantly disrupt" the film-forming composition. See col. 11, line 64 – col. 11, line 29. Example 5 shows a composition comprising wax. See instant claim 41. Examples teach that the coloring film-forming composition and overcoating composition are stored in a separate lipstick cases. See instant claim 18.

Drechsler fails to teach an overcoating composition comprising liquid polymeric hydrocarbon number average greater than about 650. The reference also fails to teach supplying the film-forming and overcoating compositions in a single stock unit.

Jennings teaches a lip composition comprising polyolefin that is fluid at room temperature and has an average molecular weight of 1300-2500. See col. 2, line 44 – col. 2, line 29; col. 4, lines 24 –30. The reference teaches that the composition is applied as a lip-gloss overcoat for use with other lip cosmetics and may be in the form of stick or cream. See col. 2, lines 40 – 59.

Litton teaches that cosmetic products that are designed to be used together are well known in the art. The reference also teaches, “often it is desirable to apply cosmetic and then use various grooming devices to enhance the applied cosmetic”. See col. 1, lines 12 – 29. The reference also mentions that such design allows consumers to carry items such as lipstick with lipliner products, which they would not otherwise. The reference teaches a makeup kit containing a reservoir for lip-gloss or lip gel; and a second compartment for “a product used with the lip gel, in this case a lipliner pencil”. See col. 3, lines 8-23. As for claims 18, 19, 43, and 46, examiner views that how the invention is handled or sold in the market does not further limit the “multipack cosmetic” (i.e., there is no structural limitation). Nevertheless, examiner views that the “kit” obviously refers to a single unit of product.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to have modified the invention of Drechsler by substituting the overcoat composition with the overcoat composition of Jennings because 1) Drechsler

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teaches that overcoating compositions enhance gloss, shine, and feel, and can be any commercially available composition which does not significantly disrupt the film-forming coloring composition; and 2) Jennings teaches a lip gloss overcoat composition that is applied over other lip composition which minimizes or prevents the migration of the coloring materials to the surrounding skin. The skilled artisan would have had a reasonable expectation of successfully making up and glossing the lips without feathering.

It would also have been obvious to the same artisan to package the lipstick and complimentary overcoat products of the combined references into one single stock unit as motivated by Litton because of the expectation that consumers can conveniently carry the complementary overcoat composition along with the lip coloring composition.

**Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler, Jennings, and Litton as applied to claims 17-19, 38-44, and 46-50 as above, and further in view of Manufacturing Chemist.**

While Jennings teach the genus of polyolefins, the combined references do not specifically mention decene-1.

Manufacturing Chemist teaches that poly-a-olefins (notably polydecene) are "popular as oil-free emollients", which are used as "pigment wetting and dispersing aids and recommended as a replacement for mineral oil". See p. 2, Base Formulation Improvements, 3<sup>rd</sup> par. These emollients are said to be "colourless, odourless, non-toxic and non-greasy and blend well with most cosmetic oils". See Id. The reference teaches that the products under PureSyn trademark from Mobil Chemicals and Arlamol

brand by Uniqema are available in different viscosity grades. See instant claims 38-40. The refractive index of the wetting agent is a physical property which is inseparable from the compound. See instant claim 42.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of Drechsler by using poly- $\alpha$ -olefins such as polydecene as taught by Manufacturing Chemist, because 1) Jennings teaches using polyolefins in an overcoating mineral oil gel compositions for lip colors; and 2) Manufacturing Chemist specifically teaches that poly  $\alpha$ -decenes are popular emollients in cosmetic art, colorless, odorless, non-toxic, and non-greasy, and good replacement for mineral oil. The skilled artisan would have had a reasonable expectation of successfully producing an overcoating lip-gloss composition with good emolliency and less greasiness.

**Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler, Jennings, Litton, and Manufacturing Chemist as applied to claims 17-19, 21, 23, 38-44, and 46-50 as above, and further in view of Finkenaur et al. (US 4935228) ("Finkenaur").**

While Jennings teaches the genus of polyolefins used in lip gloss compositions and Manufacturing Chemist teaches the subgenus of polyalphaolefins, the references do not specifically mention butene.

Finkenaur teaches lip-gloss comprising a mineral oil gel which comprising polybutene, a wear-enhancing agent. See Examples 2-5; instant claims 21 and 22. Also called "masking oil", polybutene is said to make "the lip gloss more water proof and

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permits it to retain its coloring and other beneficial effect on the wearer's lips for a substantially longer period", or up to 3 hours. See col. 3, lines 17 – 33. The reference teaches polyiso- and normal butenes supplied by AMOCO [sic] from INDOPOL, H-100, H-300, and 1500. See col. 4, lines 24 – 33. The lip-gloss composition is said to be a low pigmented, high shine lip preparation. See col. 1, lines 60 – 64.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the overcoating composition of the combined references by substituting the polyolefins of Jennings with the polybutene of Finkenaar as motivated by the references because 1) Jennings teaches using the genus of polyolefins in the lip gloss overcoating composition; 2) Manufacturing Chemist teaches that the genus of polyalphaolefins in cosmetic use; and 3) Finkenaar teaches that polybutene makes more water proof and longer-lasting lip gloss. The skilled artisan would have had a reasonable expectation of successfully producing an overcoating lip-gloss composition with enhanced waterproof and long lasting effects.

**Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drechsler, Jennings, and Litton as applied to claims 17-19, 38-44, 46-50 as above, and further in view of Nichols.**

The combined references fail to teach makeup remover composition.

Nichols teaches the method of using a make-up remover composition immediately prior to, or after applying the lipcolor composition. See col. 6, lines 54 – 59; col. 12, line 44 – col. 13, line 29. See instant claim 19 and 20.



It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the makeup kit of the combined references by further incorporating makeup remover product as motivated by Nichols because of the expectation of consumer demands for convenience.

**Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over") Drechsler, Jennings, and Litton as applied to claims 17-19, 38-44, 46-50 as above, and further in view of Chadfield et al. (US 3871543).**

The references fail to teach the material of which the container of the multipack cosmetic made.

Chadfield teaches that lightweight, medium impact styrene is well known in plastic art for its use in making cosmetic containers. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used styrene to make the multipack lip color cosmetic of the combined references, as motivated by Chadfield, because of the expectation of successfully producing a light-weight cosmetic container.

### ***Response to Arguments***

Applicant's arguments with respect to claims 17-23, 38-50 have been considered but are moot in view of the new ground(s) of rejection in part and unpersuasive in part.

Applicants argue that Manufacturing Chemist "in general teaches away from using liquid polymeric alpha olefins in a wetting agent overcoating composition". Applicants reason that the teaching of the reference does not suggest using the polyalphaolefins for the specific purpose for which applicants are using in the present

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invention, i.e., useful wetting agent overcoat compositions for an anhydrous pigmented transfer resistant composition containing the claimed components and also be non-reactive with, but affinitive to, the pigmented film. Examiner respectfully asserts that obviousness rejections may be proper even though prior art teaches motivations for a skilled artisan to make the present invention that are different from applicants' own motivations. It is well settled in patent law that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, applicants are using polyalphaolefins because of their affinity to the pigmented film. The combined references also provide sufficient motivation for a routineer to use polyalphaolefins of Manufacturing Chemist for its emolliency, comparability with other cosmetic oils, colorlessness, and colorlessness. Polyalphaolefins are also said to be non-toxic and non-greasy, wetting agents for pigments, which may be used in the overcoating composition as Drechsler teaches, and "recommended as a replacement for mineral oils". Finkenaur teaches mineral oil gel lip-gloss, thus it would have been obvious for a skilled artisan to substitute mineral oils with polyalphaolefins as taught by Manufacturing Chemist.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

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within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, all the facts and rationales are drawn from the objective teachings of the cited prior arts, and thus the rejections are proper.

Regarding the rejection made further in view of Chadfield, applicants assert, "it would be a very tortured path to arrive at the multipack cosmetic of claim 45". Examiner respectfully notes that the only claimed limitation of claim 45 is a mere "container" made of ABS, polystyrene, or polyethylene. The claimed invention in this case is two separation compositions put together in a container. The prior art teaches that it would be obvious to make a cosmetic case with polystyrene due to its lightweight. The idea of two separate compositions put together is for the convenience of consumers who carry the cosmetics, as taught by Litton. Thus it would have been obvious to the routineer to make the cosmetic case with a light polymeric material of Chadfield.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gina Yu  
Patent Examiner

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER